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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,296	04/08/2004	David L. Shannon	21790-07821	1121
758	7590	06/22/2005	EXAMINER	
FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041			LIEU, JULIE BICHNGOC	
			ART UNIT	PAPER NUMBER
			2636	

DATE MAILED: 06/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/821,296

Applicant(s)

SHANNON ET AL.

Examiner

Julie Lieu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/6 and 6/13/05</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Objections*

1. ~~Claim~~ Claim 28 is objected to because of the following informalities: it appears that claim 28 should depend on claim 27 instead of claim 15. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 5-8, 11-17, 19-22, and 26-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Breed (US Application 2003/0227382).

#### Claim 15:

Breed discloses a security state system for tracking a container through a global supply chain, comprising:

- a. a required body of information module 12 and processor coupled to receiver 26 to store information concerning the container submitted by a first trusted agent (inherent) located at a first checkpoint; and
- b. a security state module, a processor (see [0065]), coupled to the information module, the security state module initiating the security state based on the information, continuously monitoring the security state between the first checkpoint and a second checkpoint, the security state adapted to change responsive to a security breach (see para. [0056]), and the security state module sending the security state to a second trusted agent at the second checkpoint (remote monitoring center) for validation. See para. [0067].

Claim 16:

In Breed, the security state module 12 initiates the security state to a secure state responsive to an inspection by the first trusted agent (inherent).

Claim 17:

The security state module 12 in Breed further comprises to change the security state responsive to a security breach defined by security business rules. See [0082] –[0089].

Claim 19:

The information disclosed in Breed comprises authorized unsealing of the container (i.e. unauthorized door opening), and wherein the security state module changes the security state if the container is unsealed without authorization between the first checkpoint and the second checkpoint. See [0088].

Claim 20:

The information in Breed's system comprises a unique identifier assigned to a seal that locks the container, and wherein the security state module uses the unique identifier to continually monitor the seal for a status. See para [0017].

Claim 21:

The status of the container in Bowman comprises one from the group consisting of door open, attempt to open door, door closed, door locked, right door open, and more than one door open.

Claim 22:

The status in Bowman further comprises an environmental state from the group consisting of: temperature, humidity, vibration, shock, light, and radiation. See para [0033].

Claim 25:

In Breed, the module submits a required body of information, including the information, to a customs control center, and receives an inspection request responsive to the required body of information.

Claim 26:

The first agent in Breed is located at an origin port of an export country and the second agent is located at a destination port of an import country.

Claim 27:

In Breed, the required body of information module receives information from a reader at the first checkpoint through a control center (see [0096]), the security state module receives continuous monitoring information from a second reader located on the container (see [0103],

and receives a validation confirmation from a third reader at the second checkpoint through a second control center.

Claim 28:

The container in Breed comprises an RFID tag, the first, second, third readers comprise an RFID reader.

Claims 1-3, 5-8, and 11-14:

The rejection of claims 1-3, 5-8, and 11-14 recites the rejection of claims 15-17, 19-22, and 25-28, respectively, except they are method claims.

Claims 29-32:

The rejection of claims 29-32 recites the rejection of claims 15-17, respectively, except they are computer product claims.

Claims 35-36:

The rejection of claims 35 and 36 recites the rejection of claims 25-26, respectively, except they are computer product claims.

4. Claims 9, 10, 23, 24, 33, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Breed (US Application 2003/0227382).

Claim 23:

The Breed system has a seal device to detect a security breach as discussed above. Though not clearly discussed in the reference, one skilled in the art would have readily recognized that once the trusted agent at the second checkpoint confirms the security integrity of the container, the breach alarm system would be reset.

Claim 24:

Though not clearly stated, it would have been obvious to one skilled in the art to change the security state of the security state module responsive to receiving an inspection request from a customs control center because the container door once opened changes its state.

Claims 9-10:

The rejection of claims 9 and 10 recites the rejection of claims 23-24 respectively, except they are method claims.

Claims 33-34:

The rejection of claims 33 and 34 recites the rejection of claims 23-24 respectively, except they are computer product claims.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 4 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Breed (US Application 2003/0227382) in view of Hannon et al. (US Patent No. 4,688,244).

Claim 18:

Breed fails to disclose that the information store in information module comprises an expected transport route between the first checkpoint and the second checkpoint, and wherein the security state module changes the security state if the actual transport route deviates from the expected transport route. Nonetheless, this concept is old in the art as taught in Hannon et al. (Hannon) wherein the transport route is monitored besides the breaching of the container. In light of this teaching, it would have been obvious to one skilled in the art to apply this teaching in the Reed system because it would enhance the security integrity.

Claim 4:

The rejection of claim 4 recites the rejection of claim 18, except it is a method claim.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bowman et al., US 2004/0100379, discloses a method and system for monitoring containers to maintain the security thereof.



8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie Lieu whose telephone number is 571-272-2978. The examiner can normally be reached on MaxiFlex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Hofsass can be reached on 571-272-2981. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Julie Lieu', with a stylized, flowing script.

Julie Lieu  
Primary Examiner  
Art Unit 2636

Jun 20, 05